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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/677,997	10/03/2003	Mark Bonner	HI 03-01	9236

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EXAMINER

ABBOTT, YVONNE RENEE

ART UNIT PAPER NUMBER

3644

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/677,997

**Applicant(s)**

BONNER ET AL.

**Examiner**

Yvonne R. Abbott

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2004.  
2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 8/2/04 have been fully considered but they are not persuasive. With respect to most of the prior art (all but Hull and Suchowski), Applicant's arguments center primarily around the intended use of the claimed invention. Specifically, Applicant argues that the prior art devices are not designed to spin on a hub or for an animal to run thereon. Applicant is reminded that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the prior art devices are capable of accommodating an animal, and whether or not the prior art devices are *designed* to spin is not relevant as long as they are capable of performing the function. Additionally, the feature upon which applicant relies (i.e., the spinning feature) is not recited in the rejected claims at issue, and only presently appears in the newly added claims in the form of reciting a "spinning pla[ne]". With regard to the application of the Suchowski et al. ('363) reference, this prior art rejection has been withdrawn. As to the Hull ('526) reference, it is maintained that Hull discloses the claimed features of a contoured center of a disk

which accommodates a hub. Applicant argues that what the Examiner calls the contour of the Hull disk is equivalent to the attachment means of their invention, and therefore is a different feature. The Examiner disagrees since the feature at issue (i.e. the contoured center opening (82)), although capable of functioning with other parts to form attachment means, also is as Applicant claims "a contoured center portion", and by calling it by different name (namely, attachment means) does not make it a different feature or negate the fact that Hull discloses this claimed feature.

### ***Claim Objections***

2. Claims 10 and 11 are objected to because of the following informalities: in claims 10 and 11, "plain" should be replaced with --plane--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. Claims 6, 10 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is reiterated that, in claim 6, the "contours" lack prior antecedent basis. Specifically, "contours are" should be changed to --contour is--since only one (contour of the center portion of the disk) is recited in the previous claim. In claims 10 and 11, "the spinning pla[ne] of the disk" lacks prior antecedent basis.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4, 9 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Tarng et al. (US 2003/0045200). Tarng et al. show a disk (10) which is capable of being used for animal exercise comprising an upper surface and a lower surface, and a means for attaching the disk to a hub (34); wherein the disk is contoured via wall (31) and screw (32) to accommodate and conform to the shape of the hub, inasmuch as Applicant discloses conforming parts where one part fits into another; wherein the hub is a part of an activity and entertainment apparatus; wherein the contour of the center portion of the disk is contrary to the contour of the exterior or outer portion of the disk; wherein the contour of the disk is parabolic.

6. Claims 1, 4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by McClung, III (5,799,616). McClung, III shows a disk (60) which is capable of being used for animal exercise comprising an upper surface and a lower surface, and a means for attaching the disk to a hub (66); wherein the disk has a recess (64) which is

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contoured to conform to the shape of the hub; wherein the contour of the center portion of the disk is contrary to the contour of the exterior or outer portion of the disk.

7. Claims 1-4, 6-9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Ross, Jr. (4,212,131). Ross, Jr. shows a plastic disk (31) which is capable of being used for animal exercise comprising an upper surface and a lower surface, and a means for attaching the disk to a hub (32); wherein the hub is an activity and entertainment apparatus; wherein the disk is contoured to conform to the shape of the hub; wherein the contour of the center portion of the disk slopes downwardly away from the center, transitioning in the exterior or outer portion of the disk to slope upwardly at (13); wherein the contour of the center portion of the disk is contrary to the contour of the exterior portion of the disk; wherein the contour of the disk is parabolic, or arched; and wherein the surface of the disk is textured (14a, 14b, 14c).

8. Claims 1, 4, 5, 7, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson (3,454,760). Wilson shows a plastic disk (5) which is capable of being used for animal exercise comprising an upper surface and a lower surface, and a means for attaching the disk to a hub (8); wherein the disk is contoured to conform to the shape of the hub; wherein the contour of the center portion of the disk is contrary to the contour of the exterior or outer portion of the disk; wherein the means for attachment is a pin centrally located on the lower surface of the disk; wherein the contour of the disk is parabolic or arched.

9. Claims 1, 2, 4, 9 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Farhi et al. (3,272,731). Farhi et al. show a disk (10) which is capable of being used for animal exercise comprising an upper surface and a lower surface, and a means for attaching the disk to a hub (28); wherein the disk is contoured via recess (24) to conform to the shape of the hub; wherein the hub is part of an activity and entertainment apparatus; wherein the contour of the center portion of the disk is contrary to the contour of the exterior portion of the disk; wherein the contour of the disk is parabolic.

10. Claims 1, 3, 4, 6, 7 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Hull (6,578,526). Hull shows a disk (52) which is capable of being used for animal exercise comprising an upper surface and a lower surface, and a means for attaching the disk to a hub or distal end (64) of stand (54); wherein the disk is contoured at center opening (82) to conform to the shape of the hub; and wherein the contour of the center portion or center opening slopes downwardly away from the center, transitioning in the exterior or outer portion of the disk to slope upwardly at the periphery (58); wherein the contour of the center portion of the disk is contrary to the contour of the exterior portion of the disk; wherein the contour of the disk is parabolic; wherein the disk is made from metal.

11. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Saloor (5,674,101). Saloor shows a disk (3) which is capable of being used for animal exercise comprising an upper surface and a lower surface, and a means for attaching

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the disk to a hub (2); wherein the disk is contoured to conform to the shape of the hub; wherein the hub is activity equipment; wherein the surface of the disk is textured at (5).

12. Claims 1, 2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Levin (5,360,363). Levin shows a plastic flying disk (20) comprising an upper surface and a lower surface, and a means for attaching the disk to a hub (22); wherein the disk is contoured to conform to the shape of the hub; wherein the hub is activity equipment; wherein the disk contour is parabolic.

13. Claims 1, 2 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Rodemeyer (3,999,519). Rodemeyer shows a plastic disk (12) comprising an upper surface and a lower surface, and a means for attaching the disk to a hub (64); wherein the disk is contoured to conform to the shape of the hub; wherein the hub is part of a shelter/ feeding/ activity equipment; wherein the disk contour is radiused; wherein the surface of the disk is textured.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

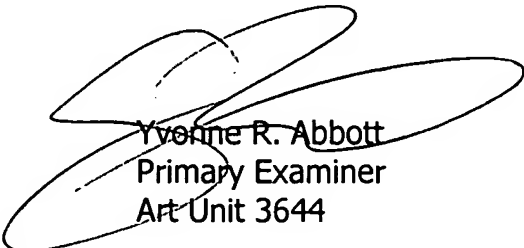


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvonne R. Abbott whose telephone number is (703)308-2866. The examiner can normally be reached on Mon-Thurs 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on (703)305-7421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yvonne R. Abbott  
Primary Examiner  
Art Unit 3644